

## **REMARKS**

Reconsideration of the application as amended is respectfully requested in view of the comments below. The Examiner's objections and rejections are addressed in substantially the same order as in the referenced office action.

Claims 1-40 are pending in this application. Claims 1, 15, 21, and 28 are independent claims. The remaining claims depend, directly or indirectly, from claims 1, 15, 21, and 28.

Claim 1 has been broadened by replacing the term "near real time" with the term used in the specifications, i.e., "real time."

Claim 15 has been broadened by replacing the term "near real time" with the term used in the specifications, i.e., "real time."

Claim 21 has been broadened by replacing the term "near real time" with the term used in the specifications, i.e., "real time." Claim 21 has also been amended to correct a typographic error.

New claim 41 has been added. Support for this claim is found, for example, at **page 15, lines 18-20.**

### **REJECTIONS UNDER 35 U.S.C § 112**

Claims 1-27 stand rejected under 35 U.S.C. § 112 ¶ 6 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Examiner has objected to the term “near real time.” This has been replaced with the term “real time.”

Independent claims 1, 15 and 21 have been amended in a manner that is believed to address the Examiner’s rejection.

### **REJECTIONS UNDER 35 USC § 103**

Claims 1-7 and 15-27 stand rejected under 35 USC § 103 over *Cwenar* (US5893079) in view of *Armitage* (US5475589) and further in view of *Bentley et al.* (US6341291). Claims 1 and 15 are independent claims.

Applicant respectfully requests clarification of this rejection as in the office action dated November 24, 2004, the Examiner stated that “Claims 1-27 would be allowable if rewritten or amended to overcome the rejection under 35 USC §112 ¶ 2.” Such an amendment was made in the response to the office action of December 2, 2004 filed on February 24, 2004. Yet the Examiner has now rejected claims 1-27 over a combination of the same references that have been of record prior to December 2, 2004.

As noted in the MPEP 706.07:

“To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

While the rules no longer give to an applicant the right to ‘amend as often as the examiner presents new references or reasons for rejection,’ present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.”

The applicant has been diligent in prosecuting the application and has not been switching from one subject matter to another in the claims presented by applicant in successive amendments. Applicant respectfully requests the cooperation of the examiner in not cutting short the prosecution of the application by rejecting in successive actions claims for substantially the same subject matter.

The rejection of claims 28-40 over the same three references was addressed in the response filed on February 24, 2005. In ¶ 1 of the present office action, the Examiner made statements regarding what combined teachings of references would have suggested

to those of ordinary skill in the art. However, the Examiner has ignored arguments made by the Applicant regarding the lack of relevance of the *Bentley* reference to the field of the present invention. These arguments are repeated here and Applicant respectfully requests that the Examiner address those arguments.

The *Bentley* reference is in the field of engineering project management. It is noted that

“Specifically, the present invention provides a management tool for tracking and managing multiple simultaneous changes to a project data set in a cohesive, secure, identifiable, and reversible way.” **Col. 1 lines 18-21**

An important essential feature of engineering project management is to maintain compatibility between updates made by individual users of the database.

“Next, the user requests that the set of components which represent the edited version of the temporary design file be updated to reflect any component changes made in the repository since the creation of the original current version of the temporary design file by other users during the user's editing time period. As part of the updating process, resolvable and unresolvable component conflicts are locally detected on a per component basis between the components which represent the edited temporary version of the design file and the latest current version of the components. The components represented by the locally updated and edited temporary version of the design file are allowed to replace the latest current version of the components in the repository only if no unresolved component conflicts exist between the two versions.” **Col. 2 lines 51-65**

This is contrary to the basic tenets of portfolio management which requires the ability to compare individual elements of the portfolio. The engineering project is a

single entity in which multiple users **may not** make changes independently of one another. In a portfolio, changes to one element do not affect the valuation of another element. For example, ExxonMobil may revalue its assets in the Gulf of Mexico if, for example, new geophysical technology increases the size of a reservoir. This revaluation may be done **independently** of the value of a property in California. In contrast, in engineering project management, changes made at one point almost invariably have an affect down the line on other aspects of the project.

Attention of the Examiner is drawn to the following from *Bentley*:

**“A transaction cannot be committed until it is known to be based on the latest committed work of others.** The process of merging is called “synchronization.” This is the key to how ProjectBank allows fine grained information sharing using coarse-grained editing tools.” **Col. 9 lines 27-31.**  
*Emphasis added.*

This quote from *Bentley* summarizes the fundamental difference between portfolio management and an engineering project management.

Admitting, for the sake of argument only, that *Bentley* is related prior art, Applicant respectfully submits that the Examiner has not met the requirements for establishing a *prima facie* case of obviousness. In ¶ 1 of the office action, the Examiner has cited three cases, *In re Fine* and *In re Jones* for support of his standard of the basis for obviousness. Applicant draws the attention of the Examiner to the following from the two cases:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n. 24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985); [**\*\*8**] ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). This it has not done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention. ***In re Fine* 837 F.2d 1071, 1074 (Federal Circuit 1988).**

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed 2-(2'-aminoethoxy)ethanol salt. ***In re Jones*, 958 F.2d 347, 351 (Federal Circuit, 1991).**

Applicant respectfully submits that the Examiner has cited nothing in the cited references, alone or in combination, suggesting or teaching the invention of claim 1 as required by *Fine*. In addition, there is no evidence on record, other than the Examiner's speculation, that one of ordinary skill in the art would have been motivated to combine the references to come up with the invention of claim 1.

As noted in previous documents filed by the applicant during the course of prosecution of this application, other courts have held even more stringent requirements

to establish obviousness.

"The factual inquiry whether to combine references must be thorough and searching." It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d

1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). *In re Lee*, 61 U.S.P.Q.2D 1430, (Fed. Circuit, 2002).

The Examiner asserts that the motivation to modify *Cwenar*, as taught by *Armitage* would be to improve the accuracy in hydrocarbon exploration and development. This appears to be an exercise in hindsight on the part of the Examiner and it is not clear to the Applicant why an inventor would modify a system for processing subscription financial data to explore for and develop hydrocarbon producing properties such as oil and gas fields, let alone to improve the accuracy of such exploration and development.

To repeat, Applicant respectfully submits that the Examiner has attempted to combine a reference from an unrelated field that is incompatible with the invention of claim 1 with two other references in a manner that fails to meet the requirements for a *prima facie* case of obviousness, and that claim 1 and claims 2-14 that depend upon claim 1 are patentable under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley*.

Claim 15, an independent claim, includes the substantive limitations of claim 1. Accordingly, applicant respectfully submits that claim 15 and claims 16-20 that depend upon claim 15 are also patentable under 35 USC § 103 over *Cwenar* in view of *Armitage*



and further in view of *Bentley* for the same reasons that claim 1 is patentable under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley*

Claim 21, an independent claim, and claims 22-27 that depend upon claim 21 are also patentable under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley* for the same reasons that claim 1 is patentable under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley*.

Claims 8-10 and 11 stand rejected under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley* and *Dembo* (US5148365).

Applicant notes that *Dembo* does not teach or suggest the particular elements of claims 1, 15 and 21 for which the Examiner relied on *Bentley* for the rejection of claim 1. Accordingly, claims 8-10 and 11 are patentable under 35 USC 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley* and *Dembo* for the same reasons that claim 1 is patentable under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley*.

Claim 12 stands rejected under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley* and *O'Shaughnessy* (US6484151).

Applicant notes that *O'Shaughnessy* does not teach or suggest the particular elements of claims 1, 15 and 21 for which the Examiner relied on *Bentley* for the

rejection of claim 1. Accordingly, claims 8-10 and 11 are patentable under 35 USC 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley* and *O'Shaughnessy* for the same reasons that claim 1 is patentable under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley*.

Claims 13-14 stand rejected under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley* and *Lu* (US6373489).

Applicant notes that *Lu* does not teach or suggest the particular elements of claims 1, 15 and 21 for which the Examiner relied on *Bentley* for the rejection of claim 1. Accordingly, claims 8-10 and 11 are patentable under 35 USC 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley* and *Lu* for the same reasons that claim 1 is patentable under 35 USC § 103 over *Cwenar* in view of *Armitage* and further in view of *Bentley*.

Claims 28-40 stand rejected under 35 USC § 103(a) over U.S. Patent No. 6,341,291 issued to *Bentley* in view of U.S. Patent No. 5,475,589 issued to *Armitage*. Claim 28 is an independent claim.

As noted above, *Bentley* is unrelated prior art and cannot be used for a rejection under 35 USC § 103.

Applicant also notes that the Examiner has correctly identified *Bentley* is

disclosing engineers and an administrator. Applicant respectfully submits that this teaching is irrelevant. Claim 28 includes “members comprising at least two selected from a geoscientist, a landman, a reservoir engineer, a regulatory compliance administrator, a right-of-way administrator, a drilling engineer, a completion engineer, a finance analyst, a field operator, a sales and marketing representative, and a portfolio manager.” The disclosure of an engineer and a system administrator who does a one time execution of step 51 (see col. 23 lines 32-35 of *Bentley*) is **not** the same as a reservoir engineer, a drilling engineer, a completion engineer, a right-of-way administrator or a regulatory compliance administrator. These are very specific terms of art and **cannot** be considered to be anticipated by a teaching of “engineers and an administrator” in *Bentley*.

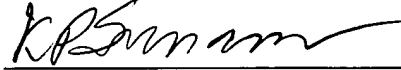
In order to sustain a rejection under 35 USC §103, the prior art of record must disclose all the limitations of the claimed invention. This is clearly lacking in the present case as there is no teaching of “members comprising at least two selected from a geoscientist, a landman, a reservoir engineer, a regulatory compliance administrator, a right-of-way administrator, a drilling engineer, a completion engineer, a finance analyst, a field operator, a sales and marketing representative, and a portfolio manager;” in either *Bentley* or in *Armitage*. Accordingly, applicant respectfully submits that claim 28 and claims 29-40 that depend upon claim 28 are patentable under 35 USC §103 over *Bentley* in view of *Armitage*.

A check in the amount of \$840.00 is enclosed for the Request for Continuing Examination and the addition of one dependent claim. The Commissioner is authorized

to charge any deficiencies and credit any surplus to deposit account 13-0010 (CON-1028).

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Respectfully submitted,



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